



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/544,881	08/08/2005	Yoshinori Kyotani	275155US0PCT	7176

22850 7590 05/12/2006

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

HABTE, KAHSAI

ART UNIT PAPER NUMBER

1624

DATE MAILED: 05/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/544,881	Applicant(s) KYOTANI ET AL.	
	Examiner Kahsay Habte	Art Unit 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/8/05& 11/8/05</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. Claims 1-23 are pending in this application.

Information Disclosure Statement

2. Applicant's Information Disclosure Statement, filed on 8/8/2005 and 11/8/2005 has been acknowledged. Please refer to Applicant's copies of the 1449 submitted herewith.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 23 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. There has been recited a method of treating a diseases caused by stimulation of interleukin-1 β production, but the specification is not enabled for such a scope.

In evaluating the enablement question, several factors are to be considered. Note *In re Wands*, 8 USPQ2d 1400 and *Ex parte Forman*, 230 USPQ 546. The factors include: 1) The nature of the invention, 2) the state of the prior art, 3) the predictability or lack

Art Unit: 1624

thereof in the art, 4) the amount of direction or guidance present, 5) the presence or absence of working examples, 6) the breadth of the claims, and 7) the quantity of experimentation needed.

The scope of the claims is not adequately enabled solely based on the inhibitory activity against interleukin-1 β production provided in the specification (see pages 310-311). First, the instant claims cover 'diseases' that are known to exist and those that may be discovered in the future, for which there is no enablement provided. The scope of pyridazinones claimed have a variety of diverse heteroaryl substituents on alkyls, alkenyls in R¹, R², R³ and X-Z variables as well as all N-containing rings at NR²R³. No examples of heteroaryl-substituted derivatives have been made much less tested. Note that piperazine derivative compounds 18, 21, 83, 143, 149, 189, 192, 213, etc. are the only examples shown for the scope of NR²R³ in the test. Test procedures and assays are provided in the specification at pages 310-311 only for 32 compounds and it is concluded that the representative compounds of formula (I) demonstrated positive inhibitory activity with IC₅₀ ranging from 0.24 μ M to 8.55 μ M, however, there is nothing in the disclosure regarding how this *in vitro* data correlates to the treatment of the diverse disorders embraced the instant claims. The disorders encompassed by the instant claims (i.e. method of treating a diseases caused by stimulation of interleukin-1 β production), some of which have been proven to be extremely difficult to treat. There is no reasonable basis for assuming that the myriad of compounds embraced by the claims will all share the same physiological properties since they are so structurally dissimilar as to be chemically non-equivalent and there is no basis in the prior art for

Art Unit: 1624

assuming the same. Note *In re Surrey*, 151 USPQ 724 regarding sufficiency of disclosure for a Markush group.

It is noted that the pharmaceutical art is unpredictable, requiring each embodiment to be individually assessed for physiological activity. In *re Fisher*, 427 F.2d 833, 166 USPQ 18 (CCPA 1970) indicates that the more unpredictable an area is, the more specific enablement is necessary in order to satisfy the statute. In the instant case, the instant claimed invention is highly unpredictable since one skilled in the art would recognize that inhibiting the interleukin-1 β production would result in only the specific site of tissue; this kind of treatment can not translated to all the possible treatment of any disease in regards to their therapeutic effects.

Hence, in the absence of a showing of correlation between all the diseases claimed as capable of treatment by the compounds and the inhibition of interleukin-1 β production, one of skill in the art is unable to fully predict possible results from the administration of the claimed compounds due to the unpredictability of the role of inhibiting the KSP kinesin i.e. whether promotion or inhibition would be beneficial for the treatment of the diseases.

The nature of pharmaceutical arts is that it involves screening *in vitro* and *in vivo* to determine which compounds exhibit the desired pharmacological activities. There is no absolute predictability even in view of the seemingly high level of skill in the art. The existence of these obstacles establishes that the contemporary knowledge in the art would prevent one of ordinary skill in the art from accepting any therapeutic regimen on its face.

Thus, factors such as "sufficient working examples", "the level of skill in the art" and "predictability", etc. have been demonstrated to be sufficiently lacking in the use of the invention. In view of the breadth of the claim, the chemical nature of the invention, the unpredictability of ligand-receptor interactions in general, and the lack of working examples regarding the activity of the claimed compounds, one having ordinary skill in the art would have to undergo an undue amount of experimentation to use the invention commensurate in scope with the claims.

Double Patenting

4. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

5. Claim 7 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of prior U.S. Patent No. 6,869,954. This is a double patenting rejection.

Art Unit: 1624

6. Claims 10-12 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-3 of prior U.S. Patent No. 6,861,428. This is a double patenting rejection.

7. Claims 4-6 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 4-6 of allowed copending Application No. 10960,993. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 1624

9. Claims 1-23 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,869,954.

Although the conflicting claims are not identical, they are not patentably distinct from each other because they embrace overlapping subject matter to a large degree as U.S. Patent No. 6,869,954. Species claimed in the instant case read on instant generic claims.

10. Claims 1-23 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,861,428.

Although the conflicting claims are not identical, they are not patentably distinct from each other because they embrace overlapping subject matter to a large degree as U.S. Patent No. 6,861,428. Species claimed in the instant case read on instant generic claims.

11. Claims 1-23 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6, 8-9, 11-12 and 14-17 of copending Application No.10/960,993. Although the conflicting claims are not identical, they are not patentably distinct from each other because there is significant overlap between the instant claims and copending Application No.10/960,993. Note that claim 1 of the instant case and claim 1 of copending Application No.10/960,993 are almost the same, except the that the heterocyclic ring

Art Unit: 1624

(i.e. NR2R3) atoms are composed of only C and N or C, N and O in the copending

Application No.10/960,993

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6, 8-9 and 13-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention:

a. Claim 1 and claims dependent thereon are rejected because the phrase “optionally substituted” is indefinite. In the absence of the specific moieties intended to effectuate modification by the “substitution” or attachment to the chemical core claimed, the term “substituted” renders the claims in which it appears indefinite in all occurrences wherein applicants fails to articulate by chemical name, structural formula or sufficiently distinct functional language, the particular moieties applicants regards as those which will facilitate substitution, requisite to identifying the composition of matter claimed.

Art Unit: 1624

b. In claims 13-16, the term “medicine” is not clear. Do applicants intend a pharmaceutical composition claim? If so, a pharmaceutically active carrier is missing. It will also duplicate claims 18-22 that are drawn to composition claims. If not, claims 13-16 duplicate the claim 1. It is recommended that applicants delete said claims.

c. In claim 17, the phrase “An interleukin-1 β production inhibitor” is not clear. Do applicants intend a method of use claim or a compound claim? If it is a method of use claim, then it should be written in a method of use claim language. If not, this is a duplicate of claim 1.

d. Claims 19-21 are rejected because they fail to narrow down the claim limitation of claim 18. Note that claims 18-21 are all drawn to the same compositions, except that claims 19-21 recite intended use that has no patentable weight. A pill is a pill whether the pill is used for the treatment of immune system or for the treatment of arthritis.

e. Claim 23 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 23, it is recited a method for treating a disease caused by stimulation of interleukin-1 β production. The scope of claim 23 is unknown. Which diseases are these? Determining whether a given disease responds or does not respond to such mediator will surely involve undue experimentation.

Art Unit: 1624

Suppose that a given inhibitor X when administered to a patient with Disease D does not obtain a response. Does one then conclude that Disease D does not fall within this claim? Keep in mind that:

A. It may be that the next patient will respond. It is quite common for pharmaceuticals to work only with some people, not all. Thus, how many need to be tested?

B. It may be that the wrong dosage or dosage regimen was employed. It is quite common for pharmaceuticals to work at one dosage, but not at another which is significantly higher or lower. Furthermore, the dosage regimen may be vital --- should the drug be given e.g. once a day, or four times in divided dosages? Thus, how many dosages and dosage regimens must be tried before one is certain that this pharmaceutical won't affect Disease D?

C. It may be that X simply isn't potent enough for Disease D, but that another inhibitor Y is potent enough, so that D really does fall within the claim. Thus, how many different mediators must be tried before one concludes that D doesn't fall within the claim?

D. Conversely, if D responds to Y but not to X, can one really conclude that D falls within the claim? It may be that the X result is giving the accurate answer, and that the success of Y arises from some other unknown property which Y is capable of. Thus, when mixed results are obtained, how many more pharmaceuticals need be tested?

Art Unit: 1624

E. Finally, suppose that X really will work, but only when combined with Z.

There are for example, agents in the antiviral and anticancer technology which are not themselves effective, but the disease will respond when the agents are combined with something else.

F. In addition, literally speaking, any disorder can be treated with any drug, although the treatment might not be successful. Assuming that "successful treatment" is what is intended, what criterion is to be used? If one person in 10 responds to a given drug, does that mean that the disease is treatable? One in 100? 1,000? 10,000?

As a result, determining the true scope of the claim will involve extensive and potentially open-ended research. Without it, one skilled in the art cannot determine the actual scope of the claim. Hence, the claim is indefinite.

f. Claim 22 provides for the use of compound of anyone of claims 1-12, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim Rejections - 35 USC § 101

13. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Art Unit: 1624

Claim 22 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kahsay Habte, Ph. D. whose telephone number is (571) 272-0667. The examiner can normally be reached on M-F (9.00AM- 5:30PM).

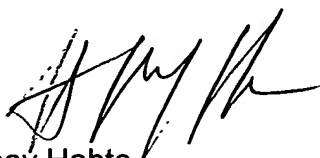
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Wilson can be reached at (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/544,881

Page 13

Art Unit: 1624

A handwritten signature in black ink, appearing to read 'Kahsay Habte', written in a cursive style.

Kahsay Habte
Primary Examiner
Art Unit 1624

KH

May 11, 2006